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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------|------------------|
| 09/994,534  | 11/27/2001  | James O'Keeffe       | M-11825 US               | 8198             |
| 36257   | 7590        | 11/02/2004           | EXAMINER<br>ERDEM, FAZLI |                  |
| PARSONS HSUE & DE RUNTZ LLP<br>655 MONTGOMERY STREET<br>SUITE 1800<br>SAN FRANCISCO, CA 94111 |             |                      | ART UNIT<br>2826         | PAPER NUMBER     |

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/994,534

Applicant(s)

O'KEEFFE ET AL.

Examiner

Fazli Erdem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-21, 24-29, 33, 34 and 38 is/are allowed.
- 6) ☒ Claim(s) 2-4, 11, 12, 22, 30, 37 and 39 is/are rejected.
- 7) ☒ Claim(s) 5-10, 13-17, 23, 31, 32, 35 and 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/11/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Allowable Subject Matter***

1. Claims 18-21, 24-29, 33, 34 and 38 allowed.
2. Claims 5-10, 13-17, 23, 31, 32, 35 and 36 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-4, 11, 12, 22, 30, 37 and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al. (6,751,365) in view of Dean et al. (6,059,627) further in view of Craig et al. (5,597,457).

Regarding Claims 2-4, 11, 12, 22, 30, 37 and 39, Zhang et al. disclose an e-field modulated bistable molecular mechanical device where in Fig. 1b, it is disclosed 2 elongate wires 12 and 14 with nanometer cross sections with coatings 20 and 22 respectively. Coatings 20 and 22 help in the modulation of the molecular mechanical device. Zhang et al. fail to disclose the components on opposite ends of the elongated nanometer scale wires and the use of an electric field larger than 1MV/m. However, Dean et al. disclose a method of providing uniform emission current where in Fig. 8, components 780 and 720 are on the opposite ends of elongated structures 760 and 775.

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Furthermore, Craig et al. disclose a system and method for forming synthetic protein crystals to determine the conformational structure by crystallography where in column 6, lines 36-42, the use of an electric field larger than 1MV/m in nanoscale applications are disclosed.

It would have been obvious to one of having ordinary skill in the art at the time the invention was made to include the required components on opposite ends of elongated nanometer scale structures and the use of e-field larger than 1 MV/m in Zhang et al. as taught by Dean et al. and Craig et al. in order to have a nanometer scale structures with increased flexibility.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fazli Erdem whose telephone number is (571) 272-1914. The examiner can normally be reached on M - F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

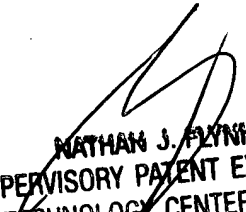
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FE

October 31, 2004

  
NATHAN J. FLYNN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800